



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,086	06/12/2000	Richard Marc Libman	LPL-0008 P3	6844
49637 7590 11/05/2007 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/592,086	LIBMAN, RICHARD MARC	
	<b>Examiner</b>	<b>Art Unit</b>	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/20/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-211 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 160-163,167,177,178,181,183,184,188,191-193,196,198,199,203,207,208 and 211.

Continuation of Disposition of Claims: Claims rejected are 1-159,164-166,168-170,179,180,182,185-187,189,190,194,195,197,200-202,204-206,209 and 210.

### DETAILED ACTION

1. This office action is in response to communication filed on 9/20/2007.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189-190, 194-195, 197, 200-202, 204-206, 209-210 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al. (5,822,735 hereinafter De Lapa).

With respect to claims 1, 53-58, 64, 116-121, 127-131, 143-148, 150-151, 153, 154-159, 164-169, 179, 182, 185-187, 189-190, 194-195, 197, 200-202, 204, 209-210 De Lapa teaches a method of automatically preparing an offering of one or more products for a specific entity (Abstract). (1) considering client data on specific entities and determining whether to offer a product to said entity (figure 6); (2) if it is determined to offer a product to said entity, then using decision information to automatically determining variable information specific to each entity for inclusion in a communication formulated to express the offering for said specific entity (see Figures 2 and 6); (3) automatically generating using at least one automated process on at least one data processing device, the communication for said specific entity within the communication device that accommodates the variable information, wherein said

Art Unit: 3622

variable information is related to said offering, and wherein the content of said offering in said communication for each entity comprises at least partially customized identification, specification and/or promotion of said product, wherein said variable information for each specific entity has at least some data that is different (see Figure 2).

De Lapa teaches that said variable information may vary among persons being offered said product or said service such that offers of said product to said persons may vary from person to person (i.e. **assigning different coupon values** to non-customer versus regular customers in order to further induce the customer to the retail store)(in De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12).

DeLapa teaches the steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

With respect to the newly added feature of the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity set who is being considered for an offer (i.e. the coupon can be assigned to more than one prior members who is eligible to receive the coupon)(col. 14, lines 33-40)

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for

Art Unit: 3622

the banks to provide additional services or products that might be needed by the customers.

With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67)

Claims 12-52, 74-115, 132-138, 142, 170, 180 further recite selecting the format for the communication and said selected delivering medium. Official notice is taken that it is well known to select different mediums in which to deliver information to users. For example, some users prefer e-mail to regular mail and this is taken into account in order to select the medium in which to deliver information.

With respect to claims 59-63, 122-126, 139-140, 205-206 the claims further recite that the services relate to mortgage loan, insurance. Official notice is taken that mortgages loans and insurance related products are well known products or services offer to clients in order to meet client's needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the services or products to be related to mortgage loans and insurance in order to obtain the above mentioned advantages.

With respect to claim 141, De Lapa further teaches providing said communication and reply means to said entity electronically (Figure 5).

With respect to claim 149, 152 De Lapa further teaches selecting a first and second delivering medium that will be used to deliver subsequent communication pertaining to said offer (Figures 1 and 5).

### **Response to Arguments**

3. Applicant states that the Examiner hasn't made reference to the status of claims 184, 197 and 204-205, the Examiner wants to point out that claim 184 depends from withdrawn claim 183 and therefore is considered to be withdrawn as well. Claims 197 and 204-205 were rejected and addressed on the body of the final rejection mailed on 3/14/2007.

4. Applicant argues that DeLapa doesn't teach offering of a financial product or services and that instead it teaches a mechanism that offers a discount on the price of a product. The Examiner wants to point out that regardless if Delapa teaches issuing a coupon for the **product** being offered, it still meets the claimed invention of offering or suggesting a specific **product** to an entity based on the coupon issued to the customer. DeLapa offer of the **product** includes the extra step of issuing a coupon for the product but nevertheless, the coupon is for a specific **product** that meets the entity or customer's criteria. In Delapa the product is not a financial product but the Examiner has taken Official Notice of replacing DeLapa grocery products with financial services is

obvious.

5. Applicant argues that DeLapa doesn't teach using variable information specific to the entity. The Examiner disagrees with Applicant because DeLapa teaches on col. 5, lines 11-17, varying the information specific to the users. **"This may be accomplished, for example, by assigning higher coupon values to non-customer of the participating retailer establishment than to regular established customers"**. So therefore, contrary to Applicant's arguments, DeLapa teaches using variable information on the product being offered specific to the user.

6. Applicant argues that DeLapa doesn't teach creating a financial product or service or both using the identity of the entity. The Examiner wants to point out that the customers criteria are used to determine which products to offer. For example, if a customer has children then coupons are created pertaining to children's products.

**Point of contact**

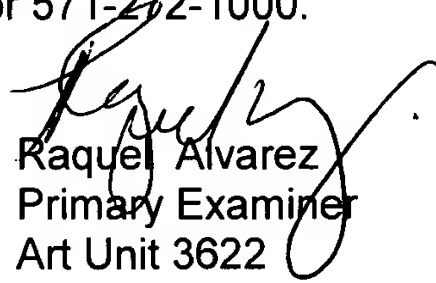
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
10/17/2007